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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,308	03/18/2004	Patricia J. Horst	502611-CIP	5768
53609 7590 07/18/2007 REINHART BOERNER VAN DEUREN P.C. 2215 PERRYGREEN WAY ROCKFORD, IL 61107			EXAMINER MENEZES, MARCUS	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,308	Applicant(s) HORST ET AL.	
	Examiner Marcus Menezes	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16, 18 and 21-40 is/are pending in the application.
 - 4a) Of the above claim(s) 2, 4, 7, 8, 10, 12, 15, 16, 18, 21-29, 36, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 6, 9, 11, 13, 14, 17, 19, 20, 30-35, 37 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to..
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 3 is objected to because of the following informalities: In line 2 "such as a carpet or the like" is unclear. Since it is in the preamble, it is not considered a problem under 35 USC § 112, but the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Further, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Appropriate correction is required.

Claims 6, 14, are objected to because of the following informalities: Line 2, "that is that is" is unclear. "That is" appears to be repeated in error. Appropriate correction is required.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3,5,6,9,11,13,14,30-35,37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cundall (GB 2113993, hereinafter "GB '993") in view of Carr (US 1731704).

GB '993 discloses an apparatus for securing a floor covering to an underlying substrate, such as a carpet or the like, where the underlying substrate includes a layer of pile extending upward from a backing, the apparatus comprising a substantially flat and planar central base member (1) adapted to be placed between a floor covering and the underlying substrate, where the central base member (1) has an upper surface (5) that is adapted to engage the floor covering, and a lower surface (2) having one or more downwardly extending spikes adapted to pass completely through the layer of pile and engage the backing of the underlying substrate for securing the apparatus to the underlying substrate as the central base member of the apparatus is rotated to screw the threaded spike through the backing. Examiner notes that the "adapted for" clause of this claim is a functional recitation of the claimed structure. An apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114). As long as the prior art is capable of performing the claimed function, then it is

considered to meet the limitations of the claim. In this case, the spike (3) of GB '993 is capable of passing through a layer of pile and engaging a backing of the substrate. However, GB '993 fails to disclose that said lone spike is threaded.

Carr teaches of a fastener including a central base member (B) and a lone downwardly extending spike (see Figures 2 and 5). Said spike is in the form of a helical thread. This thread is used to secure the fastener to the floor.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included the teaching of the lone downwardly extending threaded spike in GB '993 in view of Carr in order to provide a fastening arrangement to more securely fasten the gripper to the floor.

With respect to claims 5,6,13,14,36 and 37, GB '993 discloses the upper surface to include an adhesive that covered by a removable protective membrane (8).

With respect to claim 9, GB '993 shows a downwardly extending spike that is capable penetrating completely through the backing of an underlying substrate. Examiner notes that on page 2, lines 32-40, GB '993 discusses the possibility of the spikes being non-rounded, and the gripper being made of a rigid material. These characteristics would further enable the spike to penetrate through a backing.

With respect to claim 11, GB '993 discloses the backing of the underlying substrate defines a lower surface thereof with said spike on an outer surface thereof adapted for engaging the lower surface of the backing of the underlying substrate.

With respect to claims 30-32, see above rejection.

With respect to claims 33 and 34, Carr discloses grasping elements or torque receiving elements (inherent) to apply a torque to the apparatus. Without such elements, the threaded portion of Carr would not be able to be threaded into the floor. Thus, gripping or torque receiving element must necessarily be present in Carr to screw the threaded portion into the floor.

With respect to claim 35, GB '993 discloses said apparatus as stated above. Further, said apparatus includes a body (base member – 1) that has a height which is less than the body's lateral extension.

Election/Restrictions

3. Newly submitted claims 36,39 and 40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Said claims are drawn to a patentably distinct species of the claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36,39 and 40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

4. Applicant's arguments filed July 2, 2007 have been fully considered but they are not persuasive.

Applicant argues that GB '993 teaches away from the claimed invention. Examiner respectfully disagrees. Applicant bases their argument on the functional limitation that the claimed structure is adapted to pass through a layer of pile and engage a backing. Examiner notes that an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114). Additionally, while GB '993 discusses the spikes to bed into or grip a layer of pile, this is only a discussion of their intended use. Depending on the rigidity and form of the spikes, Examiner asserts they are capable of passing through the pile and engaging a backing. There are no structural limitations in the claim that differentiate the instant invention from the prior art.

Applicant argues that the apparatus makes no teaching or suggestion of attaching two floor coverings together. Examiner disagrees and further suggests positive recitation of said carpet rather than an intended use of said invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Applicant continues arguing for intended use limiting language, such as "adapted for." Examiner stresses that function follows form in an anticipation rejection.

Applicant argues that the fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency. Examiner notes that inherency was not relied in the rejections where it was stated that the prior art is "capable of" performing claimed functions. MPEP 2114 requires that an apparatus be distinguished from the prior art in terms of structure, not function.

Applicant argues that the combination of GB '993 and Carr is a result of impermissibly working backward from the applicant's disclosure and that the references teach away from another. However, these arguments do not specifically address the elements of the rejection made by the examiner and appear to be nothing more than an allegation of patentability.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Menezes whose telephone number is 571-272-6284. The examiner can normally be reached on 8:00am - 5:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcus Menezes
Examiner
Art Unit 3677

MM

A handwritten signature in black ink, appearing to read 'K Mitchell', written in a cursive style.

Katherine Mitchell
Primary Examiner